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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/720,927	10/04/1996	ASHER GIL	PI/3C	2200

7590 05/04/2004

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EXAMINER

COSIMANO, EDWARD R

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 05/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/720,927

Applicant(s)

GIL ET AL.

Examiner

Edward R. Cosimano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. Applicant should note the changes to patent practice and procedure:
 - A) effective December 01, 1997 as published in the Federal Register, Vol 62, No. 197, Friday October 10, 1997;
 - B) effective November 07, 2000 as published in the Federal Register, Vol 65, No. 54603, September 08, 2000; and
 - C) Amendment in revised format, Vol. 1267 of the Official Gazette published February 25, 2003.
2. The drawings filed October 04, 1996 are objected to by the examiner. Note also the PTO-948 mailed October 09, 1997.
 - 2.1 The proposed drawing correction filed February 13, 1998, has been approved by the examiner.
3. The disclosure is objected to because of the following informalities:
 - A) it is noted that the 109 pages of paper appendices as filed October 04, 1996 does not comply with the requirements of 37 CFR § 1.96(c). Note pages 1, 9, 15 & 34 which mention the appendices.Appropriate correction is required.
4. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(a)-1.121(f) & § 1.121(h)-1.121(i).
5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

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5.1 Claims 1-19 are rejected under 35 U.S.C. § 102(e) as being clearly anticipated by Ramsden (5,481,464).

5.2 It is noted that:

A) the effective filing date for the subject matter of claims 5-12 & 16-19, i.e. the transmission of user data to a central location is the filing date of the instant application, that is August 02, 1994, while,

B) the effective filing date for the subject matter of claims 5-12 & 16-19, i.e. the transmission of user data to a central location as copied from Ramsden ('464) is February 18, 1994.

Hence, the invention of claims 1-19 was known to others before the filing by applicant.

6. Response to applicant's arguments.

6.1 All rejections and objections of the previous Office action not repeated or modified and repeated here in have been over come by applicant's last response.

6.2 In regard to the objection to the appendices,

6.3 As per the 35 U.S.C. § 102(e) rejection, since:

A) the text referred to by applicant to support the use of a credit card as payment is, (reproduced below):

(1) at page 1, lines 30-35 of the 07/678,863 application now serial number 07/994,182, "The machine obtains payment from the customer, notably through the use of a prepaid, low-cost charge card which may be sold in convenient denominations at the machine's location (e.g. at a convenience store). A magnetic card reader for handling such cards may be connected through a conventional interface directly to, e.g., a convenience-store cash register. Alternatively, the customer may use a credit card to make payment."; and

(2) at page 11, lines 1-6, of the 07/678,863 application now serial number 07/994,182, "The customer is able to request an electronic mail operation (e.g., using a conventional electronic mail service such as MCI Mail) using one of the two types of floppy disc drives 124, 126 by

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inserting a floppy disk into the drive and following the voice/touch screen 110 instructions. The customer is thereby able to transmit his files to another computer. The cost of the electronic mail is deducted from the prepaid magnetic card and the card is returned to the customer.”.

B) as can clearly be seen from these passages of the 07/678,863 application now serial number 07/994,182, these passages merely enables one of ordinary skill to implement an invention that:

(1) preferably uses an inserted pre-purchased PREPAID MAGNETIC CARD that contains a monetary value as the source of payment;

(2) permits the loading of electronic mail data or electronic data files;

(3) permits the transmitting/receiving of electronic mail data or electronic data files to/from a remote location;

(4) deducts the cost of transmitting/receiving the electronic mail data or electronic data files from the available monetary value that has been stored in/on the inserted PREPAID MAGNETIC CARD;

(5) returns the inserted PREPAID MAGNETIC CARD to the owner of the card with the remaining monetary value; and

(6) suggests that a credit card may be used as the source of payment, but fails to teach or suggest to one of ordinary skill how the above invention which uses a prepaid card payment system would be modified to implement the use of credit card as the source of payment.

C) in view of the above teachings, it can not be seen how the above quoted text from the 07/678,863 application now serial number 07/994,182 would enable one of ordinary skill to:

(1) in regard claims 1-9 & 13-15, to either:

(a) use a credit card, (note also claim 8); or

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(b) insert a credit card, which is recognized as being functionally different than a PREPAID MAGNETIC CARD, i.e. a debit card, because a credit card does not store a monetary value; or

(c) insert a credit card, which is recognized as requiring a payment process that is functionally different than the payment process for a PREPAID MAGNETIC CARD, i.e. a debit card, because a credit card does not store a monetary value; or

(d) the transmit credit data to a remote location for billing the customer, since as taught and suggested in the 07/678,863 application now serial number 07/994,182, the transmitted data/information does not originate from the payment system.

(2) in regard to claim 7 to:

(a) transmit shipping manifest data to a remote location, since as taught and suggested in the 07/678,863 application now serial number 07/994,182, the transmitted data/information does not originate from a manifesting system.

Since, in the 07/678,863 application now serial number 07/994,182, only the electronic mail data or electronic data files is transmitted and while the manifest data is stored at the "Automated Self-Service Package Shipping Machine".

(3) in regard claims 10-12 to either:

(a) transmit shipping fee data to a remote location for billing the customer, since as taught and suggested in the 07/678,863 application now serial number 07/994,182, the transmitted data/information does not originate from the payment system.

(4) in regard to claims 16-18 to:

(a) use a customer's account for billing the shipping fee, since as taught and suggested in the 07/678,863 application now serial number 07/994,182, the transmitted data/information does not originate from the payment system.

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(5) in regard to claim 17 to:

(a) transmit shipping fee data to a remote location for billing the customer, since as taught and suggested in the 07/678,863 application now serial number 07/994,182, the transmitted data/information does not originate from the payment system.

(6) in regard to claims 9, 11 & 18 to:

(a) validate the credit card before issuing a shipping label for the customer, since as taught and suggested in the 07/678,863 application now serial number 07/994,182, the transmitted data/information does not originate from the payment system.

(7) in regard claim 19 to either:

(a) transmit shipping fee data to a remote location for billing the customer, since as taught and suggested in the 07/678,863 application now serial number 07/994,182, the transmitted data/information does not originate from the payment system; or

(b) transmit shipping manifest data to a remote location, since as taught and suggested in the 07/678,863 application now serial number 07/994,182, the transmitted data/information does not originate from the manifesting system.

Since, in the 07/678,863 application now serial number 07/994,182, only the electronic mail data or electronic data files is stored at the "Automated Self-Service Package Shipping Machine".

6.3.1 Further in regard to the 35 U.S.C. § 102(e) rejection, since, the payment processing required for either a credit card or debit card transaction as is well known is quite different and more extensive than the payment processing required for a prepaid card, which stores the remaining balance, the merely making a brief mention by applicant that payment could be made by credit card fails to provide the support required to enable the invention as now claimed. Note in regard to finding support within the disclosure for the claimed invention, applicant is reminded that "To establish inherency, the extrinsic evidence must make clear that

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the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted).

6.4.2 It is further noted that applicant failed to make an incorporation by reference to the disclosures of the parent applications. Therefore those disclosures do not form part of the instant disclosure, hence, applicant may not rely on any external disclosure in order to provide essential support for the presently claimed subject matter.

6.4.3 Hence, applicant's argument's are non persuasive.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss, can be reached on (703)-308-2702. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

7.1 The fax phone number for UNOFFICIAL/DRAFT FAXES is (703) 746-7240.

7.2 The fax phone number for OFFICIAL FAXES is (703) 872-9306.

7.3 The fax phone number for AFTER FINAL FAXES is (703) 872-9306.

04/28/04



Edward R. Cosimano
Primary Examiner A.U. 3629